

### Remarks/Arguments

This is responsive to the Office Action mailed October 18, 2005. The amendments are proper, serve to more particularly point out and distinctly claim that which is patentable over the references of record, do not introduce new matter, do not require additional searching, and are broadening and thus not narrowing in view of a prior art rejection.

### Rejection Under 35 USC 103

Claims 1-21 were rejected as being unpatentable over Frees '059 in view of Watanabe '189. This rejection is respectfully traversed.

### Claims 1, 11, and 21

The Examiner has failed to substantiate the requisite prima facie case of obviousness because the cited references do not, neither alone nor in combination, teach or suggest all the features of the present embodiments as recited by each of the independent claims which include at least the following:

*A servo track writer assembly...comprising...a gas-lubricated bearing with a working fluid comprising helium....*  
(excerpt of claim 1, emphasis added)

*A method for recording servo pattern information on a disc, the method comprising...maintaining separation of opposing bearing surfaces with a working fluid in a gas-lubricated bearing....*  
(excerpt of claim 11, emphasis added)

*A gas-lubricated bearing with a working fluid comprising helium.*  
(claim 21, emphasis added)

The Examiner is obligated as a matter of law to apply to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as

they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification. *In re Morris*, 44 USPQ2d 1023, 1028 (Fed. Cir. 1997). Failure to do so is reversible error.

Here, Applicant agrees with the Examiner to the extent that Frees '059 fails to teach or suggest a gas-lubricated bearing with a working fluid comprising helium. (Office Action of 10/18/2005, pg. 3). However, Applicant expressly traverses the Examiner's implication that Watanabe '189 cures the deficient disclosure of Frees '059.

The claim term "gas-lubricated bearing" is a term of art having ordinary meaning to a skilled artisan as being a bearing wherein the opposing bearing surfaces are spatially supported in non-contacting engagement. A gas-lubricated type of bearing, also commonly referred to as a "fluid bearing," plainly does not contemplate the use of roller bearings such as the anterior bearing 3a, 3b and the posterior bearing 4 of Watanabe '189. These roller bearings have an inner race contactingly engaging the spindle 5 and an outer race contactingly engaging the housing 2, thereby maintaining the spatial separation between them. Thus, it is the roller bearings and not the fluid atmosphere around the roller bearings that maintain the separation between the spindle 5 and the housing 2.

This ordinary meaning of the claim term "gas-lubricated bearing" is consistent with its usage in the specification, which discloses some embodiments employing hydrostatic bearings and other embodiments employing hydrodynamic bearings. Both of these types of bearings are well-known to the skilled artisan as generally being "gas-lubricated" type bearings that do not have roller bearings contactingly engaging the opposing bearing surfaces. (see, for example, specification pg. 14 lines 25-31) Furthermore, the specification

discloses and claim 11 explicitly recites structure commonly associated with “gas-lubricated” type bearings, and distinguishing over a roller bearing such as Watanabe ‘189, whereby the working fluid maintains the bearing surface separation. (see, for example, specification pg. 3 lines 26-27; pg. 13 line 19; pg. 14 lines 25-27; pg. 14 lines 12-15; pg. 16 lines 1-3; claim 11 lines 9-12.

The Examiner’s claim term construction is unreasonable because it ignores the ordinary meaning to the skilled artisan, consistent with the ascribed meaning in the specification, of the claim term “gas-lubricated bearing.” *In re Morris*, 43 USPQ2d 1753 (Fed. Cir. 1997). The Examiner’s stated motivation for combining these references is irrelevant because the references are wholly silent regarding the use of a gas-lubricated bearing, but rather both employ spindle assemblies with roller bearings. The teaching or suggestion to make the claimed combination must be found in the prior art and not based on Applicant’s disclosure. *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991)

The examination resulting in the present rejection is incomplete because the Examiner has failed to substantiate a prima facie case of obviousness in considering the patentability of the invention as claimed. 37 CFR 1.104(a). Particularly, the cited references do not substantiate a prima facie case of obviousness because they do not teach or suggest all the features of the present embodiments as claimed, nor is there any motivation from the references to modify and/or combine them to arrive at the present embodiments as claimed. The incompleteness of the first action prevents the next action from being a final rejection on the merits. Reconsideration and withdrawal of the present rejection of claims 1, 11, and 21 and the claims depending therefrom are respectfully requested.

**Allowable Subject Matter**

Applicant gratefully acknowledges the indication of allowable subject matter in claim 17. However, Applicant has opted not to place claim 17 in independent form at this time because the independent claim from which it depends is allowable for the reasons above.

**Conclusion**

This is a complete response to the Office Action mailed October 18, 2005. The Applicant requests reconsideration and withdrawal of all rejections.

The Applicant has also included herewith a request for telephone interview to clarify the unresolved issues concerning the incomplete examination resulting in the present rejections.

The Examiner is invited to contact the Attorneys listed below should any questions arise concerning this response or request for interview.

Respectfully submitted,

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